intervening dependencies. Accordingly, the scope of claims 169, 178-180, 192, 221, 234, 239, 250, 255, 277, 284-285, 312, 314 and 317 remains unchanged and, thus, have not been narrowed. Claims 177, 185, 194, 200, and 313 have been amended by modifying the claim from which they are dependent. Claims 189 and 190 have been amended to further clarify which set of output receptacles that the bills is being directed. Thus, no new matter has been entered and the amendment should not require a new search. The Applicants respectfully request that the amendments be entered.

Thus, claims 169-187, 189-190, 192-201, 221-224, 234-248, 250-257, 268-272, 277-285, 301-305, 312-314, 317-319, and 322-329 will be pending in the application upon entry of the amendment. Reconsideration of the claims in view of the following remarks is respectfully requested.

I. IDS Consideration

The Applicants filed a Third Information Disclosure Statement on May 29, 2002 (after the mailing date of the outstanding office action, but before receipt of the Office Action by the Applicants). The Applicant would respectfully request that the Examiner review these references and make them of record.

II. Obviousness-Type Double Patenting Rejections

Claims 164-329 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of the following U.S. Patent Nos. 5,295,196; 5,430,664; 5,467,405; 5,790,697; 5,806,650; 5,815,592; 5,867,589; 5,870,487; 5,875,259; 5,905,810; 5,992,601; 6,012,565; 6,073,744; 6,220,419 B1; 6,237,739 B1; 6,241,069 B1; 6,278,795 B1 and 6,311,819 B1. To formulate an obviousness-type double patenting

rejection, the claims of the pending application must be compared to the claims of an application or a patent. See MPEP 804. In the Office Action, none of the claims of the above-identified U.S. patents has been specifically identified as relating to the obviousness-type double patenting rejections.

In order to allow the Applicants to adequately respond to this rejection, the Applicants respectfully request an identification of the specific claim(s) of each of the above-identified U.S. patents or, alternatively, for these obviousness-type double patenting rejections to be withdrawn. For example, U.S. Patent No. 5,295,196 has one independent claims that recites, *inter alia*, "transporting bills, in the direction of the narrow dimension...", "a stationary optical scanning head...", "means for sampling said output signal at preselected intervals...." and "a memory for storing characteristic signal samples...each of said stored signal samples being proportional to the intensity of light reflected from a different strip of said preselected segment of a bill". The pending claims do not include all, if any, of such features and further have additional features directed to halting of the bill failing to meet a non-piece criteria which are not recited in any of the claims of the U.S. Patent No. 5,295,196. Therefore, it is clear that such a rejection based on U.S. Patent No. 5,295,196 is believed to be improper and should be withdrawn. It is also believed that all of the other obviousness-type double patenting are also believed to be improper, but since none of the claims of the above-identified U.S. patents has been specifically identified as relating to the obviousness-type double patenting rejections, the Applicants cannot properly respond to these rejections.

III. Provisional Obviousness-Type Double Patenting Rejections

Claims 164-329 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 164-327 of copending Application Nos. 09/541,170 and 09/542,487; claims 157, 158 and 164-190 of copending Application No. 09/635,967; claims 164-337 of copending Application No. 09/607,019; claims 1-145 of copending Application No. 09/684,103; and claims of Application No. 09/126,580.

To obviate some of the provisional obviousness-type double patenting rejections, the Applicants will file a terminal disclaimer with respect to Application Nos. 09/541,170, 09/542,487 and 09/607,019 when the other rejections have been withdrawn provided such terminal disclaimer remains necessary.

With respect to the remaining provisional obviousness-type double patenting rejections, the Applicants respectfully request the withdrawal of such rejections because the claims of each of the applications have many elements that are not present in any of the claims of the present application. As discussed above, a provisional obviousness-type double patenting rejection involves comparing the claims of the present application to that of a second application.

Specifically, the claims of Application No. 09/684,103 differ from the claims of the present application. For example, claim 1 of Application No. 09/684,103 recites several elements that are not recited in the present invention (*e.g.*, "detecting the presence or absence of magnetic ink in a plurality of zones," and "comparing the detected information concerning which zones contained magnetic ink...."). Other claims of Application No. 09/684,103 recite some of the same elements, as well as additional elements that are not recited in the present application including elements directed to a magnetic scanhead, a memory adapted to store master security thread location and

detecting the presence of a security thread. The claims of the present application also have elements that are not present in the claims of Application No. 09/684,103.

The claims of Application No. 09/635,967 also differ from the claims of the present application. For example, claim 1 of Application No. 09/635,967 recites several elements that are not recited in the present invention (*e.g.*, "a memory adapted to store information associated with a plurality of modes of operation of the device", "the memory being designed to store at least one user-defined mode of operation", "the user-mode of operation being capable of subsequent recall and selection of a user....", "an interface adapted to permit a user of the evaluation device to define the user-defined mode of operation" and "a mode selection element"). Other claims of Application No. 09/635,967 recite some of the same elements, as well as additional elements not recited in the claims of the present application. The claims of the present application also have elements that are not present in the claims of Application No. 09/635,967.

The claims of Application No. 09/126,580 differ from the claims of the present application. For example, claim 1 of Application No. 09/126,580 recites several limitations that are not recited in the present invention (*e.g.*, "a control panel having an input device adapted to receive input from an operator of the device" and "a processor...programmed to...enable the operator, upon suspension of the operation of the device to designate via the control panel the denomination of a bill whose denomination is not determined by the processor" and "enable the operator, upon suspension of the operation of the device, to restart the operation of the device without designating the denomination of a bill whose denomination is not determined by the processor)". Other claims of Application No. 09/126,580 recite some of the same elements, as well as additional elements not recited in the claims of the present application. The claims of the

present application also have limitations that are not present in the claims of Application No. 09/126,580.

Thus, the Applicants believe that the provisional obviousness-type double patenting rejections with respect to Application Nos. 09/684,103, 09/635,967 and 09/126,580 should be withdrawn.

The Applicants believe that Application No. 09/864,423 recited in the Office Action is not an application owned by the assignee of the present application. The Applicants note that Application No. 08/864,423 is an application owned by the assignee of the present application and issued as U.S. Patent No. 6,311,819, which was recited in the obviousness-type double patenting rejection.

IV. 35 U.S.C § 103(a) Rejections

A. U.S. Patent No. 5,419,423 to Ishida

Ishida does not teach or suggest at least one feature of each and every claim of the present invention. For example, each of the independent claims recites, *inter alia,* (a) receiving a stack of bills in an input receptacle, (b) halting the transporting when a flagged bill from the stack of bills meets or fails to meet a non-piece criterion, and (c) counting the denomination of bills.

Ishida is directed to "a paper money processor" used "for determination of whether or not the inserted paper money is genuine." Col. 2, lines 8-9 and 20-21. Specifically, Ishida discloses that it is "a machine for handling paper moneys as a vending machine" in which "the paper money [is] fed through the paper money transporter section 4 into a paper money accommodation box 6". Col. 1, lines 12-13, col. 4, lines 22-24.

The Office Action stated the following: "[i]t is considered that receiving bills in the form of stacks is well known in the art as a form to present bills to a bill sorting apparatus." In support of this statement, the Office Action apparently has relied upon Takesako (U.S. Patent No. 4,694,963), which discloses an apparatus for sorting sheets. This statement in the Office Action, however, is not applicable because there is no teaching or suggestion in Ishida for an input receptacle that receives a stack of bills. In fact, Ishida teaches away from such an input receptacle in that a vending machine receives one bill at a time directly from the customer. Thus, there is no teaching or suggestion of including an input receptacle adapted to receive a stack of bills in the vending machine processor of Ishida.

Furthermore, it is improper to combine the paper money processor of Ishida adapted to be used in a vending machine with the apparatus for sorting sheets of Takesako. These references are fundamentally different and there is no motivation or suggestion to combine these references. The device of Ishida does not halt the flagged bill from a stack of bills that meets or fails to meet a non-piece count related criterion. Ishida does not receive a stack of bills from the input receptacle of the device and, thus, cannot transport or halt bills from the stack of bills.

Additionally, there is no teaching or suggestion of counting bills in the 32-column disclosure of Ishida. The fact that Ishida determines whether bills are genuine or false does not teach or suggest the counting of the bills.

Also, some of the independent claims (independent claims 221, 234, 239, 250, 255, 277, 284 and 285) have a feature directed to the speed of processing the bills of at least 800 bills per minute. There is no teaching or suggestion of having such a speed obtained in the device of

Ishida used in vending machines. In fact, Ishida teaches away from such speeds by having customers place one bill at a time in the vending machines.

Thus, independent claims 169, 178-180, 189, 190, 192, 221, 234, 239, 250, 255, 268, 277, 284, 285, 301, 312, 314, 317, 322, and 326 are not obvious over Ishida or the combination of Ishida and Takesako. Claims 170-177, 181-187, 193-201, 222-224, 235-238, 240-248, 251-254, 256, 257, 269-272, 278-283, 302-305, 313, 318, 319, 323-325, and 327-329, which depend either directly or indirectly on a respective one of the above-identified independent claims should be allowable over Ishida or the combination of Ishida and Takesako for at least the same reasons.

B. U.S. Patent Nos. 5,201,395 to Takizawa and 5,301,786 to Yoshihara

Takizawa and Yoshihara also do not disclose, *inter alia*, (a) receiving a stack of bills in an input receptacle (b) halting the transporting when a flagged bill from the stack of bills meets or fails to meet a non-piece criterion, and (c) counting the denomination of bills. Such features are recited in all of the independent claims of the present application.

As discussed above, the Office Action stated the following: "[i]t is considered that receiving bills in the form of stacks is well known in the art as a form to present bills to a bill sorting apparatus." This statement in the Office Action is not applicable because there is no teaching or suggestion in either Takizawa or Yoshihara for an input receptacle that receives a stack of bills.

Takizawa is directed to "a bill examination device used in an automatic cash deposit/dispensation machine or an automatic vending machine". Col. 1, lines 5-9 and col. 2, lines 23-28. The device of Takizawa does not have an input receptacle adapted to receive a stack of bills. See, *e.g.*, col. 1, lines 11-17 ("[w]hen a bill (i.e., bank note or paper currency) is inserted

or entered by a customer into an automatic cash deposit/dispensation machine or an automatic vending machine, the denomination of the bill is identified and the authenticity of the bill is tested.").

Yoshihara is directed to "validating a paper-like piece such as a bill or bank note, a note used as a substitute for money, a gift card or a bill made of plastics...." Col. 1, lines 9-12 and col. 3, lines 64-68. The device of Yoshihara, as shown in, for example, FIG. 5, does not have an input receptacle adapted to receive a stack of bills, but rather appears to be used in a similar manner as Takizawa (*i.e.*, in a automatic cash deposit/dispensation machine or an automatic vending machine).

In fact, both Takizawa and Yoshihara teach away from such an input receptacle that receives a stack of bills. Takizawa and Yoshihara disclose an automatic cash deposit/dispensation machine or an automatic vending machine that receives one bill at a time directly from the customer. There is no teaching or suggestion of including an input receptacle adapted to receive a stack of bills in the automatic cash deposit/dispensation machine or an automatic vending machine vending machine processor of Takizawa or Yoshihara. The devices of Takizawa and Yoshihara do not halt the flagged bill from a stack of bills that meets or fails to meet a non-piece count related criterion. The devices of Takizawa and Yoshihara do not receive a stack of bills from the input receptacle of the device and, thus, cannot transport or halt bills from the stack of bills.

Furthermore, it is improper to combine the processor of Takizawa or Yoshihira that is adapted to be used in a cash deposit/dispensation machine or an automatic vending machine with the apparatus for sorting sheets of Takesako. Takizawa and Yoshihira are fundamentally different

from Takesako and there is no motivation or suggestion to combine these references. For example, there is no teaching or suggestion that adding multiple output receptacles from Takesako would increase "work output and efficiency" in Takizawa as stated in the Office Action. In fact, such an addition of multiple outputs would increase the complexity of the transportation path. Such a reason does not provide motivation or suggestion to combine these references.

Additionally, there is no teaching or suggestion of counting bills in the disclosures of Takizawa and Yoshihara. The fact that Takizawa and Yoshihara disclose that bills are determined to be genuine or false does not teach or suggest the counting of the bills. The statement mentioned in the Office Action with respect to Yoshihara ("such apparatus and method capable of performing accurate validation and collation...") does not support counting of the bills. Yoshihara discloses its validation and collation process at, for example, col. 5, lines 25-40 in which the fourth step is as follows: "the data to be examined is collated with the standard pattern to determine whether the deposited paper-like piece is true or false." The collation process of Yoshihara has nothing to do with counting the bills.

Also, some of the independent claims (independent claims 221, 234, 239, 250, 255, 277, 284, and 285) have a feature directed to the speed of processing the bills of at least 800 bills per minute. There is no teaching or suggestion of having such a speed obtained in the devices of Takizawa and Yoshihara used in a cash deposit/dispensation machine or an automatic vending machine. In fact, Takizawa and Yoshihara teach away from such speeds by having customers place one bill at a time into their respective machines.

Thus, independent claims 169, 178-180, 189, 190, 192, 221, 234, 239, 250, 255, 268, 277, 284, 285, 301, 312, 314, 317, 322, and 326 are not obvious over Takizawa, Yoshihara or

the combinations of Takizawa, Yoshihara, and Takesako. Claims 170-177, 181-187, 193-201, 222-224, 235-238, 240-248, 251-254, 256, 257, 269-272, 278-283, 302-305, 313, 318, 319, 323-325, and 327-329, which depend either directly or indirectly on a respective one of the above-identified independent claims should be allowable over Takizawa, Yoshihara, or the combinations of Takizawa, Yoshihara, and Takesako for at least the same reasons.

C. U.S. Patent No. 5,761,089 to McInerny

McInerny, does not disclose, *inter alia*, (a) two or more output receptacles and (b) determining the denomination of the bills. Such features are recited in all of the independent claims of the present application.

McInerny discloses a counterfeit document detection apparatus that includes only one output receptacle. See FIGs. 1 and 2a, and col. 3, line 58-col. 4, line 3. The Office Action states that "receiving stacks of bills and feeding them to two or more output receptacles would be a matter of design choice, based upon the output or workflow required". Applicants respectfully traverse this argument. Rather, McInerny contains no teaching or suggestion to use two or more output receptacles. Specifically, there is no motivation to modify the device of McInerny to use a more complicated and costlier transportation path for processing bills in the counterfeit document detection apparatus of McInerny. This clearly appears to be impermissible hindsight. Additionally, pursuant to MPEP § 2144.03, the Applicants respectfully request that the Examiner cite a reference in support of the above statement. Otherwise, the Applicants cannot further evaluate this statement and respond accordingly.

The apparatus of McInerny does not denominate bills, but rather is a document counting and handling device that can count, verify and stack a particular type of document, such as

currency of the same denomination. See generally col. 1, lines 18-20; col. 2, lines 3-7 and 34-40; col. 3, lines 58-63 and col. 11, line 65 to col. 12, line 43. There is no teaching or suggestion of denominating bills in McInerny. In fact, McInerny discloses the opposite in that the user enters the denomination of the particular bill that is being counted in the batch ("[t]he DENOM SELECT key is used during step 226 of the control procedure to cycle through a list or menu to select that the denomination of bills to be counted in a particular run or to specify a piece count without regard to denomination"). Col. 18, lines 12-16 of McInerny.

Furthermore, McInerny does not disclose that "halting is performed such that the flagged bill is positioned as the last bill in the one of the output receptacles" as is recited in some of the independent claims (claims 169, 178-180, 189, 190 and 192). Rather, McInerny discloses that "[s]ince the document transport mechanism cannot be instantaneously stopped, both the counterfeit suspect and the next document in the input stack, if any, are delivered to the stacker as the motor is halted in step 290. The control procedure then passes to step 291 in which normal operation is resumed by removal of the counterfeit suspect and the next document from the stacker, placing the next document back into the hopper, and pressing the CONT key." Col. 21, lines 49-56.

Thus, independent claims 169, 178-180, 189, 190, 192, 221, 234, 239, 250, 255, 268, 277, 284, 285, 301, 312, 314, 317, 322, and 326 are not obvious over McInerny. Claims 170-177, 181-187, 193-201, 222-224, 235-238, 240-248, 251-254, 256, 257, 269-272, 278-283, 302-305, 313, 318, 319, 323-325, and 327-329, which depend either directly or indirectly on a respective one of the above-identified independent claims should be allowable over McInerny for at least the same reasons.

D. U.S. Patent No. 3,759,382 to Walkley

Walkley, does not disclose, *inter alia*, many features that are being presently claimed in the pending independent claims of the present application. For example, Walkley does not teach or suggest (a) "wherein the halting is performed such that the flagged bill is positioned as the last bill in one of the output receptacles" that is recited in independent claims 169, 178-180, 189, 190 and 192, (b) counting and denominating U.S. bills at a rate of at least 800 bills per minute, flagging suspect bills, and directing "stranger bills and no call bills to a first set of one or more of the output receptacles and directing suspect bills to a second set of one or more of the output receptacles, the output receptacles of the second set being different from the output receptacles of the first set" as recited in independent claim 221, (c) counting and denominating at a rate of at least 800 bills per minute, and halting the transporting when a no call bill is determined as recited in independent claims 234, 250 and 255, (d) counting and denominating at a rate of at least 800 bills per minute and halting the transporting when a suspect bill is determined as recited in independent claims 239, 250, and 255, (e) "halting the transport mechanism when a bill is determined to be suspect" or "stopping a transport drive motor in response to a stopping signal" in response to the suspect signal as recited in independent claims 268 and 301, (f) counting and denominating at a rate of at least 800 bills per minute and flagging bills that meet or fail to meet any of certain non-piece criteria wherein the flagged bill that meets or fails to meet at least a given set of the criteria positioned in one of the output receptacles as recited in independent claims 277 and 285, (g) flagging bills that meet or fail to meet any of certain non-piece criteria wherein the flagged bill that meets or fails to meet at least a given set of the criteria positioned in one of the output receptacles, including no calls bills, as recited in independent claims 277, 312, 314, and

317, and (h) various features related to routing and presenting bills in three output receptacles as recited in independent claims 284, 322, and 326. Walkley does not teach or suggest such features that are being recited in the independent claims of the present invention.

Thus, independent claims 169, 178-180, 189, 190, 192, 221, 234, 239, 250, 255, 268, 277, 284, 285, 301, 312, 314, 317, 322, and 326 are not obvious over Walkley. Claims 170-177, 181-187, 193-201, 222-224, 235-238, 240-248, 251-254, 256, 257, 269-272, 278-283, 302-305, 313, 318, 319, 323-325, and 327-329, which depend either directly or indirectly on a respective one of the above-identified independent claims should be allowable over Walkley for at least the same reasons.

CONCLUSION

The Applicants submit that the claims are in a condition for allowance and action toward that end is earnestly solicited. Applicants have enclosed herewith a clean version of the pending claims after entry of this Amendment. In addition, Applicants have enclosed herewith a check in the amount of $420.00 for additional claims. The Commissioner is hereby authorized to charge deposit Account No. 10-0447 (47171-00269USC1) for any fees inadvertently omitted which

may be necessary now or during the pendency of this application, except for the issue fee.

Dated: August 23, 2002

Respectfully submitted,

John C. Gatz
Reg. No. 41,774
JENKENS & GILCHRIST
225 West Washington Street, Suite 2600
Chicago, Illinois 60606
312.425.3900
Attorney for Applicants